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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,346	03/26/2004	Russell Bonaventura	LEAP:128US	1571

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EXAMINER

PRITCHETT, JOSHUA L

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,346

Applicant(s)

BONAVENTURA ET AL.

Examiner

Joshua L. Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7 and 9-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-32 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7 and 9-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Amendment filed December 14, 2005. Claims 1-3, 5-7, 9-15, 17, 18 and 20-25 have been amended and claims 4 and 8 have been cancelled as requested by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7 and 9-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonaventura (US 2004/0246571).

Regarding claims 1, 5, 13 and 14, Bonaventura teaches a removable interchangeable adjustment knob (12) magnetically fastenable to an adjustment means (para. 0023). Bonaventura teaches the adjustment means comprise adjusting the objective lens (para. 0022). Bonaventura further teaches a rotatable shaft (para. 0023) and reliably fastening the adjustment knob (para. 0023). Bonaventura lacks specific reference to a focus means. It is extremely well known in the art that adjusting the objective lens can change the focusing of a microscope. Official Notice is taken. It would have been obvious to a person of ordinary skill in

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the art at the time the invention was made to have the Bonaventura invention adjust the focusing means of the microscope by adjusting the objective lens as is known in the art for the purpose of aligning the objective within the microscope (para. 0022).

Regarding claims 2 and 6, Bonaventure teaches the adjustment means has a rotatable shaft (para. 0023).

Regarding claims 3, 7 and 23, Bonaventura disclose the adjustment knob is adapted for complementary magnetically attractive engagement with the adjustment means (Fig. 2; para. 0023).

Regarding claim 9, Bonaventure teaches a second adjustment means (12; Fig. 1).

Regarding claim 11, Bonaventura teaches the removable interchangeable adjustment knob is magnetically fastenable to the second adjustment means (para. 0023).

Regarding claim 12, Bonaventure teaches the adjustment means comprising a first adjustment knob (12) and a removable adjustment knob (12; Fig. 1), the first adjustment knob and the removable adjustment knob coaxial and independently rotatable with respect to one another (Fig. 1).

Regarding claim 15, Bonaventura teaches the removable adjustment knob is fastenable by means operatively arranged for preventing separating movement of the removable adjustment knob axially away therefrom and the second means tending to allow rotation with the removable adjustment knob (para. 0023).

Regarding claim 16, Bonaventura teaches the means is magnetic (para. 0023).

Regarding claims 17, 24 and 25, Bonaventura teaches the second means comprising pin (18) means extending axially from the removable adjustment knob and pin receiving means complementarily extending axially from the attached location (Fig. 2; para. 0023).

Regarding claim 18, Bonaventura teaches one of the pin means and pin receiving means is formed of magnetic material and the other is magnetically attractable material (para. 0023).

Regarding claim 19, Bonaventura teaches the invention as claimed but lacks reference to moving the microscope stage. It is extremely well known in the art to move the microscope stage in the vertical direction to adjust the focusing of a microscope. Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Bonaventura invention include a microscope stage movable in a vertical direction as is known in the art for the purpose of adjusting the focusing of a microscope.

Regarding claim 20, Bonaventura teaches at least two adjustment means and two removable adjustment knobs disposed on opposite sides of the microscope (Fig. 1).

Regarding claim 21, Bonaventura teaches the invention as claimed but lacks reference to one adjustment knob being longer than the other. It has been held (In re Reinhart) that changes in size are within the skill of one of ordinary skill in the art at the time the invention was made. One would have been motivated to change the size of one of the adjustment knobs for the purpose of connecting to a magnetic socket deeper within the body of the microscope.

Regarding claim 22, Bonaventura teaches the adjustment means comprising a first adjustment knob (12) and a removable adjustment knob (12; Fig. 1), the first adjustment knob and the removable adjustment knob coaxial and independently rotatable with respect to one another (Fig. 1). Bonaventura lacks specific reference to the knobs having different axial

lengths. Bonaventura suggests the first and second knobs having different axial lengths (Fig. 1). Fig. 1 shows additional adjustment knobs located near the bottom of the microscope. The adjustment knobs appear to have one over top of the other. The first knob closer to the microscope body would have a shorter axial length than the second knob situated on top of the first knob. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Bonaventura adjustment knobs have different axial lengths as suggested by Bonaventura for the purpose of locating adjustment knobs on at the same location to allow an operator to operate both knobs without having to look away from the sample to determine which adjustment knob is being actuated.

Regarding claim 26, Bonaventura teaches the first and second drive focus means are on opposite sides of the microscope (Fig. 1).

Response to Arguments

Applicant's arguments, see Amendment, filed December 14, 2005, with respect to objection to claims 20 and 26 have been fully considered and are persuasive. The objection of claims 20 and 26 has been withdrawn.

Applicant's arguments filed December 14, 2005 have been fully considered but they are not persuasive.

Applicant argues that the inventive entity for the prior art is the same as the current application. The current application has three inventors, while the prior art reference lists a single inventor therefore the inventive entities are not the same.

Applicant argues that the current application and the prior art reference have been commonly assigned. It is not clear that the current application is commonly assigned with the prior art because the names for the two assignees differ. Further, one assignee has an address in Germany while the other has an address in Buffalo, NY.

Applicant argues that the prior art does not teach focus adjustment because it only teaches alignment of the objective lens. The applicant's argument hinges on the difference between adjusting the objective lens and aligning the objective lens. The prior art states the adjustment means can "adjust or align" the objective lens (para. 0015 and 0021). Therefore the prior art reference would be able to adjust the focus by adjusting the objective lens. Applicant further argues that the prior art does not include an interchangeable focus adjustment knob. The prior art reference states "at least one" adjustment means (para. 0009), which suggests that the prior art may include two such means and that the means may be interchangeable. Indeed the prior art reference shows two adjustment means (12) that appear to be interchangeable. Applicant further argues that they are not magnetically fastenable. The examiner interprets magnetically fastenable to be capable of fastening magnetically to one another. The prior art further states that the adjustment means are capable of magnetically fastening (para. 0023).

Applicant argues that the prior art lacks two separate parts that can rotate independently. As stated previously the prior art includes two adjustment means (12). One adjustment means can be labeled the focus adjustment and the other can be labeled the removable focus adjustment.

Applicant's arguments, see Amendment, filed December 14, 2005, with respect to claim 27 have been fully considered and are persuasive. The rejection of claim 27 has been withdrawn.

Allowable Subject Matter

Claims 27-32 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding claim 27, the prior art fails to teach or suggest a first and second focusing means each comprising a course focus adjustment knob and a fine focus adjustment knob and two focus drive means wherein each of the fine focus adjustment knobs are releasably fastened to either of the focus drive means.

Claims 28-32 depend from claim 27 and are allowable for the same reasons.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

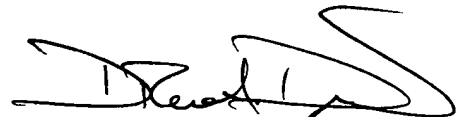
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP



DREW A. DUNN
SUPERVISORY PATENT EXAMINER